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No. 03-1129

In The
Supreme Court of the United States

SHOKETSU KINZOKU KOGYO
KABUSHIKI CO., LTD., a/k/a SMC CORPORATION
AND SMC PNEUMATICS, INC.,

Petitioners,

v.

FESTO CORPORATION,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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RESPONDENT'S STATEMENT OF THE QUESTIONS PRESENTED

Respondent, Festo Corporation respectfully submits that this case does not present any relevant questions for review as defined in Sup. Ct. R. 10.

PARTIES TO THE PROCEEDING

Pursuant to S. Ct. Rule 29.6, Respondent, Festo Corporation, states that its parent corporation is Festo AG.

There are no subsidiaries or affiliates of Festo Corporation or Festo AG that have issued shares to the public.

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STATEMENT OF THE CASE

Petitioner ("SMC") improperly presents its entire argument in the Statement of the Case. Below is a statement of the proceedings leading to SMC's petition. Respondent Festo Corporation ("Festo") will address SMC's arguments in the section entitled "Reasons for Denying the Petition."

Festo is the owner of two U.S. Patents found to be infringed by SMC after a jury trial and a summary judgment motion in the district court. Some of the accused devices were found to have literally infringed the claims of Festo's patents, while other devices incorporating trivial changes were found to infringe under the doctrine of equivalents. SMC appealed the findings of infringement under the doctrine of equivalents. On two occasions, a unanimous panel of the Federal Circuit affirmed. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 172 F.3d 1361 (Fed. Cir. 1999); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 72 F.3d 857 (Fed. Cir. 1995). After rehearing *en banc*, however, the Federal Circuit severely restricted the doctrine of equivalents by holding that prosecution history estoppel creates a "complete bar" to reliance upon *any* range of equivalents for amended claim elements, thus permitting near-identical copying of the patented product. The complete bar rule was rejected by this Court and a rebuttable presumption was created. This Court set forth specific bases under which a patent holder could present evidence to rebut the presumption and establish that the accused equivalent was not surrendered by the claim amendment. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 740-741 (2002).

1. *Prosecution History of Festo's Patents.* The Stoll and Carroll patents are directed to linear actuators known as "magnetic rodless cylinders." Briefly stated, these devices are employed in a wide range of industrial applications to transport articles from one point to another. The cylinders include three basic components: a piston, a cylinder, and a sleeve. The piston sits inside the cylinder and is driven by pressurized fluid. The sleeve sits outside the cylinder and is magnetically coupled to the piston. Accordingly, movement of the piston back and forth within the cylinder tube causes the sleeve likewise to move back and forth along the cylinder without the need for any mechanical linkage between the piston and sleeve. This allows the device to move articles or machinery as desired. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 579 (Fed. Cir. 2000).

The U.S. Patent and Trademark Office ("PTO") initially rejected the pending claims in the Stoll patent application under 35 U.S.C. §112 ¶ 1, which requires that the patent contain "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." The patent examiner concluded that the "exact method of operation [was] unclear" because he was unsure whether the device operated as "a true motor or magnetic clutch." (Pet. App. 36a). The examiner also objected to the claims under ¶ 2 of 35 U.S.C. §112 because they were in improper multiple dependent form. *Id.* Dr. Stoll submitted new claims in order

to *clarify* the nature of the device. (Pet. App. 36a-37a), *Festo*, 172 F.3d at 1379.[1] The original claim made no mention of a sleeve and the specification disclosed only a sleeve made of magnetizable material. The original claim defined a sealing means at both ends of the piston, and the specification disclosed only the use of two sealing rings, one at each end of the piston. *Festo*, 234 F.3d at 582-583.

The relevant amendments to the Carroll patent occurred after Festo voluntarily submitted that patent for re-examination in view of a German prior art reference that had not been considered during the original prosecution. During that proceeding, Carroll amended the claim without prompting from the examiner.[2]

The SMC devices that were found to infringe the Stoll and Carroll patents under the doctrine of equivalents are identical to the claimed inventions save in two insubstantial respects.[3]

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[1] Specifically, Dr. Stoll included within his broadest claim (independent claim 1) two limitations relevant here: (i) that there be two sealing rings disposed on the piston and (ii) that the outer sleeve of the device be made from magnetizable material. Both limitations had originally appeared in dependent claims when the application was first filed. (Pet. App. 37a), *Festo*, 172 F.3d at 1379.

[2] The claim was amended to include, among other things, two sealing rings, but Festo argued that what distinguished the amended claims was that the prior art did not "teach or render obvious the claimed combination which includes the plurality of magnets, end members, and cushion members in the claimed relationship." *Festo*, 172 F.3d at 1373.

[3] *First*, rather than having a one-way sealing ring on each end of the piston, the SMC devices have a single two-way sealing ring located at one end of the piston. *Second*, the sleeve of the SMC device is made of an aluminum alloy. *Festo*, 535 U.S. at 729.

2. *The Proceedings Below.* Festo sued SMC for infringing the Stoll and Carroll patents. The United States District Court for the District of Massachusetts granted summary judgment in favor of Festo, concluding that SMC's rodless cylinders infringed the Carroll patent under the doctrine of equivalents. Thereafter, a jury found that SMC infringed the Stoll patent under the doctrine of equivalents. *Festo*, 234 F.3d at 578.

On SMC's appeal, a Federal Circuit panel affirmed in full. *Festo*, 72 F.3d at 868. After denial of rehearing, SMC petitioned for *certiorari*. This Court granted *certiorari*, vacated the judgment and remanded the case for further consideration in light of its then-recent decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), in which the Court unanimously reaffirmed the vitality of the doctrine of equivalents.

In the case at hand, on remand in the wake of *Warner-Jenkinson*, another Federal Circuit panel reinstated the prior findings that SMC's devices contained no differences of substance from the patented inventions. With respect to the Stoll patent, the panel held that one amendment was voluntary, not made to avoid the prior art, and thus prosecution history estoppel did not apply. *Festo*, 172 F.3d at 1380. Because the other amendment in this patent presented an "unresolved issue," however, the Federal Circuit panel remanded to the district court to determine, *ab initio*, whether the *Warner-Jenkinson* presumption should apply and if so, whether it could be rebutted. *Id.*

3. *The En Banc Decision:* The Federal Circuit reheard the case *en banc* and, in a sharply divided 8 to 4 decision, reversed the finding of infringement under the doctrine of equivalents as to both patents. *Festo*, 234 F.3d at 558. The

en banc majority concluded that prosecution history estoppel acts as a "complete bar" to the application of the doctrine of equivalents to an amended element. *Festo*, 234 F.3d at 563-564. Based on this ruling, the majority reversed the district court's finding of infringement relying solely on estoppel. *Festo*, 234 F.3d at 564. Left intact, as the law of this case, were the findings that SMC's devices embodied no substantial differences from Festo's patented inventions.

4. *This Court's Festo Decision*: In a unanimous decision, this Court rejected the complete bar imposed by the Federal Circuit. "The Court of Appeals ignored the guidance of *Warner-Jenkinson,* which instructed that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community." *Festo*, 535 U.S. at 739. This Court acknowledged that "patent prosecution occurs in the light of our case law. Inventors who amended their claims under the previous regime had no reason to believe they were conceding all equivalents. If they had known they might have appealed the rejection instead. There is no justification for applying a new and more robust estoppel to those who relied on prior doctrine." *Id.* This Court also recognized that "[prosecution history estoppel's] reach requires an examination of the subject matter surrendered by the narrowing amendment. The complete bar avoids this inquiry by establishing a *per se* rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place--to hold the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment." *Festo*, 535 U.S. at 737-738.

This Court found that "[t]here is no reason why a narrowing amendment should be deemed to relinquish equivalents unforeseeable at the time of the amendment and

beyond a fair interpretation of what was surrendered. Nor is there any call to foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted." *Festo*, 535 U.S. at 738. A presumption that a narrowing of a claim through amendment is a general disclaimer of the territory between the original claims and the amended claims was created.

> There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.

Festo, 535 U.S. at 740-741.

This Court further noted that:

> [t]his presumption is not, then, just the complete bar by another name. Rather, it reflects the fact that the interpretation of the patent must begin with its literal claims, and the prosecution history is relevant to construing those claims. When the patentee has chosen to narrow a claim, courts may presume the amended text was composed

> with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed.

Festo, 535 U.S. at 741.

The Federal Circuit decision was then vacated and remanded to the Federal Circuit for further proceedings. *Festo*, 535 U.S. at 742.

5. *The En Banc Decision on Remand*: The Federal Circuit issued an *en banc* order requesting briefing by the parties on the following four issues:

> 1. Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.
>
> 2. What factors are encompassed by the criteria set forth by the Supreme Court.
>
> 3. If a rebuttal determination requires factual findings, then whether, in this case, remand to the district court is necessary to determine whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted, or whether the record as it now stands is sufficient to make those determinations.
>
> 4. If remand to the district court is not necessary, then whether Festo can rebut the

> presumption that any narrowing amendment surrendered the equivalent now asserted.

(Pet. App.5a-6a).

In the decision on remand, the Federal Circuit held that the question as to whether a patentee had overcome the presumption was entirely one of law; and therefore, it was only for the judge to determine whether the *Festo* presumption was rebutted. (Pet. App. 9a-10a). In addressing question 2, the court limited the evidence which could be introduced to overcome the presumption. Specifically, as to the tangentialness criteria, the court restricted the evidence to that found in the prosecution history. (Pet. App. 13a). The court also determined that the "some other reason" criteria had to be a narrow one and that evidence of this should also be limited to the file history. (Pet. App. 14a). As to issues 3 and 4, on the prosecution record and the trial record, both developed well before the *Festo* presumption was created, the Federal Circuit decided that this record could not establish that the reason for the amendment was tangential or that there was some other reason to support a showing that there was no surrender. (Pet. App. 16a-17a, 19a-20a). The case was remanded to the district court with only the issue of foreseeability to be determined by the district court judge. (Pet. App. 21a). Festo believes that this restricted remand was improper and has filed its own Petition for Writ of Certiorari. (U.S. Sup. Ct. Docket No. 03-1133).

Circuit Judge Newman joined by Chief Circuit Judge Mayer vigorously dissented the majority's decision refusing to give Festo a full and fair hearing in the district court to rebut the newly created *Festo* presumption based on the tangential and some other reason criterion. (Pet. App. 31a-32a).

REASONS FOR DENYING THE PETITION

SMC's position is founded upon a tortured reading of this Court's precedent and the record below, which vitiates the *Festo* presumption and assures that claim elements narrowed for reasons related to patentability (which has been construed to be nearly every conceivable amendment) will be completely barred from access to the doctrine of equivalents. SMC misconstrues *Festo* to concoct a non-existent "fundamental test" for overcoming the *Festo* presumption that no patent holder could pass. SMC again seeks to have this Court adopt a complete bar for amended claim elements despite this position being clearly and unambiguously rejected by this Court.

On the particular questions presented in SMC's petition, the Federal Circuit followed the new rebuttable presumption in accordance with this Court's precedent, rather than an incorrect complete bar as suggested by SMC. Thus, SMC has failed to identify an important federal question which was decided by the Federal Circuit in a way that conflicts with this Court's precedent. Sup. Ct. R. 10.

Furthermore, SMC's petition is entirely insensitive to the balance sought by this Court when the *Festo* presumption was established. SMC's approach would give a competitor a roadmap to make trivial changes not captured in drafting the patent claim thus undermining valid patent rights granted to innovators. SMC's petition seeks to encourage imitators, not innovators, in direct contrast to the essence of the United States patent system and its petition should be denied.

A. SMC's Petition Should Be Denied Since The Federal Circuit Followed This Court's Precedent On The Issue Of Foreseeability

In *Festo,* this Court rejected a complete bar rule enacted by the Federal Circuit. This Court recognized that "[t]here are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent." *Festo*, 535 U.S. at 740. Instead, this Court created a rebuttable presumption that gives the patentee the right to establish that a narrowing amendment did not surrender the accused equivalent. Three specific criteria for overcoming the presumption of surrender were set forth by this Court:

> The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.

Festo, 535 U.S. at 740-741.

Further emphasizing that the presumption was to be rebuttable, this Court stated that "[t]his presumption is not, then, just the complete bar by another name." *Id.* at 741.

The Federal Circuit, following this Court's remand instructions, examined each of these criteria to determine whether Festo could rebut such a presumption. The *en banc*

court unanimously found that the case should be remanded to the district court to determine if the accused equivalents were foreseeable at the time of the amendment. As to the issue of foreseeability, which is the only issue material to this petition, the Federal Circuit properly followed this Court's decision and remanded the case to the district court.[4] In the district court, Festo will be given an opportunity for the first time to present evidence to show that the accused equivalents were not foreseeable to one skilled in the art. This is precisely the result mandated by a proper reading of this Court's precedent. Since the Federal Circuit correctly remanded the case to the district court based on foreseeability, there is no requisite conflict with this Court's precedent and SMC's petition should be denied.

B. SMC's Petition Should Be Denied Since It Is Contrary to This Court's Precedent

SMC finds error with the court below based on a misreading of this Court's precedent. SMC's entire argument is based upon the incorrect premise that if a claim narrowed during prosecution could have been drafted to literally cover the accused device, then access to the doctrine of equivalents is barred. This is clearly not a plausible reading of this Court's decision and none of the Federal Circuit judges adopted SMC's overreaching construction.

To support its contention, SMC relies heavily on a misinterpretation and misapplication of this Court's statement "[w]hen, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the

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[4] The Federal Circuit found that Festo could not rebut the presumption based upon the "tangential" or "some other reason" criteria. Festo has filed its own Petition for Writ of Certiorari (U.S. Sup. Ct. Docket No. 03-1133), on issues surrounding these improper findings.

claim on response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent." *Festo*, 535 U.S. at 733-734. However, this statement clearly refers to a situation where the patent applicant literally set forth in the claim the accused equivalent in question and then narrowed the element at issue such that the accused device is no longer literally encompassed by the amended element, i.e., a clear surrender of subject matter. Such a situation is "classic" prosecution history estoppel whereby an applicant, in view of the scope of the prior art, narrows his claims by amendment to obtain allowance, thereby disclaiming the broader scope of the original claim. With respect to the statement at issue, this Court relied on its decision in *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942).

In *Exhibit Supply*, the patentee sought to recapture through equivalents a claim construction that was surrendered via amendment due to a prior art rejection. Specifically, the patentee originally claimed conductor means "carried by the table" which was necessarily amended to be "embedded in the table" to overcome the prior art rejection. *Exhibit Supply*, 315 U.S. at 136. The file history, through statements by the examiner and the applicant, made it clear that a claim including the broad "carried by" language would not be allowable over the prior art. During litigation, the patentee sought to invoke the doctrine of equivalents to cover accused devices in which the conductor means was "carried by" the table and not within the literal scope of the "embedded in the table" limitation. *Id.* at 135. To allow such a construction would have negated the amendment and essentially ignored the narrowing amendment. This Court correctly applied classic notions of

prosecution history estoppel to prevent this recapture of subject matter that was clearly disclaimed. This is a very different situation from that in which the claim prior to amendment did not literally define the accused equivalent.

More specifically, SMC's argument incorrectly confuses the factual situation in which an original claim specifically recites the accused equivalent with the factual situation in which the original claim can be read to cover the accused device. The first instance demonstrates that the patentee knew of the equivalent and how to claim it. The second instance imparts no such insight, since an applicant may not have even included the element at issue in the claim, i.e., the claim could be read to cover the accused device since the element at issue was not in the claim at all. This is the case at bar.

In the Stoll application, the original claim did not define a sleeve at all, let alone define a sleeve made of any material. Additionally, the specification only disclosed that the sleeve was made of a magnetizable material. Furthermore, the reason for the amendment, *i.e.*, addressing the examiner's uncertainty as to whether the claimed device was a linear motor or magnetic clutch, had nothing to do with the sleeve or sleeve material. Festo never had a claim including an element of a sleeve made of an aluminum alloy, the SMC accused equivalent.

With respect to the sealing rings on the piston, the original Stoll claim defined "sealing means" at each end of the piston, and the specification only disclosed a piston including a sealing ring at each end. Furthermore, the reason for the amendment, i.e. to clarify the nature of the amendment, had nothing to do with sealing rings. Festo never had a claim which defined a single, two-way sealing

ring on the piston, the SMC accused equivalent. Thus, Festo did not have an original claim which literally included the accused equivalents at issue and the notions of classic prosecution history estoppel under *Exhibit Supply* were not applicable as noted by Circuit Judge Newman in her dissent:

> At the trial prosecution history estoppel was not at issue; SMC told the district court that "this is not really a prosecution history estoppel case." (citation omitted).

(Pet. App. 43a).

Accordingly, the present case is highly distinguishable from the facts of *Exhibit Supply*. This distinction was also clearly recognized by this Court, which determined that the record did not permit a determination as to whether Festo could rebut the presumption, thereby necessitating a remand for further findings consistent with the newly created presumption. *Festo*, 535 U.S. at 741-742.

In clear contradiction to the essence of this Court's decision, SMC contends that if the original claim covered the accused device, the amended claim necessarily surrenders all equivalents. An original claim which did not include the accused equivalent clearly does not undermine a patentee's right to rebut the presumption. SMC improperly relies on a blatant misrepresentation of the Federal Circuit's opinion. (Pet. 3). The court below never made a finding that Festo's original claims literally covered the accused SMC device. SMC's citation to the Federal Circuit decision only supports a finding that the claims had been narrowed by amendment, thereby invoking the newly created presumption.

SMC further focuses improperly on a single word of this Court's decision while ignoring the rest of the decision

to fabricate what it refers to as a "fundamental test". (Pet. 5). This Court set forth two specific criterion for overcoming the presumption, including unforeseeability and tangentialness with respect to the reason for making the amendment to the equivalent in question. A third rebuttal category provides that a patentee could present "some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." *Festo*, 535 U.S. at 741. This category is clearly a recognition by this Court that reasons other than unforeseeability or tangentialness may exist to establish that a narrowing amendment does not surrender the equivalent; at issue, i.e. a general "catch-all" for situations not necessarily contemplated by the Court at the time of the opinion to permit a patentee the requisite flexibility to rebut the new presumption which was a sea change in the law.

SMC uses this third category to improperly impose an additional limitation on the first two, namely, that if the words existed so that the original claim could have been drafted to literally cover the accused equivalent, then all equivalents are completely barred. In theory, once the accused infringer has made its insubstantial change to avoid literal infringement, the words always exist so that a claim could have been drafted to literally cover the accused device. As stated above, if SMC's "fundamental test" were the law, this Court would not have rejected the complete bar rule.

Contrary to SMC's assertions (Pet. 6), the Federal Circuit's finding that Festo could not demonstrate "some other reason" does not in any way answer the question whether the equivalents were foreseeable. Festo contends that the Federal Circuit's holding on the "some other reason" issue and tangentialness issue are clearly erroneous and has filed its own Petition for Writ of Certiorari seeking this

Court's review. (U.S. Sup. Ct. Docket No. 03-1133). SMC's position is again based on its incorrect contention that by simply not describing the element at issue at all in the claims, one could have literally covered the accused device. This is not the criteria set forth in this Court's decision and would, in effect, create a complete bar in direct conflict with this Court's holding in *Festo*. Therefore, SMC's petition should be denied.

C. SMC's Petition Should Be Denied Since It Would Create A Complete Bar

The practical impact on the patent system resulting from SMC's interpretation of *Festo* is a complete bar by another name. The purpose of the *Festo* presumption is to permit the patent holder to establish that the insubstantial modification or trivial change to avoid literal infringement is equivalent to the claimed structure and that such equivalent has not been disclaimed or surrendered by the narrowing amendment. For the *Festo* presumption to arise: (1) the claim must be narrowed during prosecution for a reason relating to patentability; and (2) the patent holder must assert that the accused device includes structure which is equivalent to the narrowed claim element.

It is nearly always the case that the claim before a narrowing amendment would have covered the accused device since it was broader in scope. It is only in situations where the amendment added or narrowed a claim element that resort to the doctrine of equivalents becomes necessary. Thus, when a claim is narrowed, it creates a *Festo* presumption situation. However, if such a narrowing surrendered all equivalents as SMC contends, then there is no need for the *Festo* presumption, and a complete bar is established. SMC's misapplication of this Court's precedent

would necessarily result in a complete bar to equivalents, since the words always exist to have drafted a claim which literally covers the accused device. Whether the equivalent was foreseeable at the time of the amendment or whether the reason for the amendment was tangential to the equivalent at issue becomes entirely irrelevant. Such a result is clearly contrary to the precedent of this Court.

The question of prosecution history estoppel only arises when a competitor develops a device or process which includes every element of a patentee's claim or its equivalent. Innovators who truly add to their field of endeavor can clearly avoid infringement of a claim since they introduce substantially different ways of addressing and solving a problem. It is the imitators making insubstantial changes who run afoul of the doctrine of equivalents. The balance tips further in favor of the imitator, at the expense of the innovator, when the *Festo* presumption becomes more difficult to overcome. SMC's petition seeks to have this Court enact a complete bar to equivalents which would be devastating to the patent system and the expectation of patent holders. This Court has previously refused such an invitation and should do so again by denying SMC's petition.

CONCLUSION

For the reasons set forth above, SMC's petition should be denied.

Respectfully submitted,

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